

Remarks

Reconsideration of this Application is respectfully requested.

Upon entry of the foregoing amendment, claims 220-522 are pending in the application, with 220, 234, 254, 276, 289, 307, 327, 340, 354, 371, 385, 402, 416, 434, 451, 464, 478, 493, 505, and 512 being the independent claims. Claims 22-33, 35-51, 53, 55-70, 72, 75-81, 84-89, 92-105, 108-114, 118, 120-124, 126-141, 144-152, 156, 158-161, 165-173, 176-195, and 198-219 are sought to be cancelled without prejudice to or disclaimer of the subject matter therein. New claims 220-522 are sought to be added. These changes are believed to introduce no new matter, and their entry is respectfully requested. As discussed in the interview held on May 22, 2001, Applicants submit herewith a claim chart which lists the previously pending claims, and the new claims which correspond to each. These changes are believed to introduce no new matter, and their entry is respectfully requested.

The Examiner noted in Paper No. 28 that claims 178-191, 194, and 198-208 were allowable. These claims correspond exactly to new claims 478-491 and 493-504, respectively. During the interview held on May 22, 2001, the Examiner further agreed that claim 193 was improperly rejected under 35 U.S.C. § 112, first paragraph. New claim 492 corresponds to canceled claim 193, but differs slightly from claim 193 in that it more properly refers to the antecedent "nucleic acid" in claim 478.

Based on the above amendment and the following remarks, Applicants respectfully request that the Examiner reconsider all outstanding objections and rejections and that they be withdrawn.

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Interview with the Examiner

Applicants thank Examiner Claire Kaufman for the courtesy extended in the personal interview held on May 22, 2001 with Eric Steffe, Jonathan Klein, and Elizabeth Haanes. Applicants further thank Examiners Kaufman and Elizabeth Kemmerer for the follow-up telephone interview held on May 31, 2001. The claims presented herein and the following remarks reflect the issues that were discussed in those interviews.

Rejections under 35 U.S.C. § 112

The Examiner has rejected claim 176 under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite. Paper No. 28 at page 2. Claim 176 has been canceled, and is not represented by a new claim (see the chart appended hereto as Exhibit A). Accordingly, this rejection is rendered moot.

The Examiner has rejected claims 22, 23, 26, 32, 37-43, 48, 49, 55-70, 72, 75-81, 84-88, 92-105, 108-114, 118, 120, 121, 123, 128-141, 144-152, 156, 158, 159, 169-173, 177, 193, 195, and 209-219 under 25 U.S.C. § 112, first paragraph, as allegedly being not enabled. The Examiner has further objected to claims 24, 25, 27-31, 33, 35, 36, 44-47, 50, 51, 53, 89, 122, 124, 126, 127, 160, 161, and 165-168 as depending upon these rejected claims. Among these rejected claims, the Examiner identifies two types of claims which are allegedly not enabled:

[claims] drawn to i) either a polynucleotide not identical to SEQ ID NO:1 or a polynucleotide encoding SEQ ID NO:2 [or the extracellular domain of SEQ ID NO:2], wherein the claimed polynucleotide has no function or a function not commensurate in scope with the limited structure required by the claims, ii) or a polynucleotide identical to only a fragment

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of SEQ ID NO:1 or the encoding polynucleotide, wherein the claimed polynucleotide has no stated function.

Paper No. 28 at page 3. In short, the Examiner argues that in order to meet the enablement requirement, claimed polynucleotides should either encode the full length DR4 polypeptide or the EC domain of the DR4 polypeptide, or such polynucleotides should either (a) be usable as a probe to detect SEQ ID NO:1, or (b) encode a polypeptide with a stated function.

Solely to advance prosecution, and not in acquiescence to the Examiner's rejections, Applicants have canceled all the pending claims, and have added new claims 220-522. Correspondence of these new claims to the subject matter of the canceled claims is shown on the claim chart attached hereto as Exhibit A (independent claims are shown in bold). For those claims in which the claimed polynucleotide is less than 100% identical to SEQ ID NO:1, or a fragment thereof, but need not necessarily encode a polypeptide, the claim recites that the polynucleotide, or a sufficiently large nucleic acid comprised therein, hybridizes to SEQ ID NO:1 under specified conditions, or otherwise functions as a probe to detect SEQ ID NO:1. For those claims in which the claimed polynucleotide encodes a polypeptide less than 100% identical to the full length DR4 polypeptide encoded by SEQ ID NO:2, the DR4 extracellular domain, or fragment thereof; or where the claimed polynucleotide encodes a fragment of the DR4 polypeptide (other than the complete extracellular domain), the claim recites that the polypeptide encoded by the claimed polynucleotide has a stated function, *i.e.*, either bind TRAIL, function as part of a DR4 polypeptide to induce apoptosis, or bind an antibody with specificity for the polypeptide of amino acids 24 to 468 of SEQ ID NO:2.

Based on these remarks, Applicants respectfully request that the enablement rejection under 35 U.S.C. § 112, first paragraph, as applied to the pending claims, be withdrawn.

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Change of Correspondence Address

Paper No. 28 was sent to Applicants directly, using the original attorney docket number. On November 2, 1999, the PTO was notified that prosecution of this application had been transferred to the law firm of Sterne, Kessler, Goldstein & Fox, P.L.L.C. at the address shown below. Furthermore, the docket number was changed. In support of this, Applicants submit herewith copies of the Change of Correspondence Address form and the post card stamped as received by the PTO on November 2, 1999 (Exhibit B). Applicants respectfully request that the records relating to this application be updated, and that all future correspondence be sent to Sterne, Kessler, Goldstein & Fox, P.L.L.C., using the attorney docket number **1488.1300002/EKS/EJH**, as shown at the top of this pleading.

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Conclusion

All of the stated grounds of objection and rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding objections and rejections and that they be withdrawn. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C.



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Date: August 7, 2001

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Version with markings to show changes made

Claims 22-33, 35-51, 53, 55-70, 72, 75-81, 84-89, 92-105, 108-114, 118, 120-124, 126-141, 144-152, 156, 158-161, 165-173, 176-195, and 198-219 are canceled.

Claims 220-522 are new.

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